UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,338	01/26/2001	Neil Fishman	13768.158	6789

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EXAMINER
SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td colspan="2">Application No.</td><td colspan="2">Applicant(s)</td></tr>
<tr><td colspan="2">09/771,338</td><td colspan="2">FISHMAN ET AL.</td></tr>
<tr><td></td><td>Examiner</td><td></td><td>Art Unit</td><td></td></tr>
<tr><td></td><td>Kristie Shingles</td><td></td><td>2141</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 February 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7,9-24 and 26-35</u> is/are pending in the application.

    4a) Of the above claim(s) <u>8 and 25</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7,9-24 and 26-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant has amended claims 1, 10, 20 and 27 and cancelled claims 8 and 25.
Claims 1-7, 9-24 and 26-35 are pending.

Response to Arguments

1.   Applicant's arguments with respect to claims 1, 10, 20 and 27 have been considered but

are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   **Claims 1-7, 9-24 and 26-35** are rejected under 35 U.S.C. 103(a) as being unpatentable

over *Kikinis* (USPN 6,553,410) in view of *Verkler et al* (USPN 5,850,517).

a.   **Per claims 1 and 20** (differ by statutory subject matter), *Kikinis* teaches a

computerized system that includes a content server, a mobile gateway, and a first and a second

mobile client, the first and second mobile clients differing from each other in at least one

operating characteristic, wherein the mobile gateway receives content that is addressed to the

first and second mobile clients from the content server, a method of customizing the content

based on at least one operating characteristic of each mobile client, wherein the customizing

avoids further processing at the content server, the method comprising a mobile gateway

performing the acts of:

- assigning a first transform to the first mobile client and assigning a second transform to the second mobile client, the first and second transforms specifically considering one or more operating characteristics of the first and second mobile clients (**col.11 lines 12-48, col.13 lines 35-66 and col.15 lines 1-65; specific translations and processes are performed on content prior to transmission to the specific user devices, wherein the transposing of data performed according to pre-stored characteristics of the users' devices**);

- receiving content from the content server (**Figures 1-5, col.13 lines 35-66 and col.15 lines 1-65; content is received from content/web/proxy server**);

- altering the content according to the first and second transforms so that the content is compatible with the one or more operating characteristics of the first and second mobile clients, the altered content comprising a first transformed content and a second transformed content (**col.11 lines 12-48, col.12 lines 11-27, col.13 lines 35-66, col.15 line 1-col.16 line 48 and col.28 lines 30-63; content is transposed according to the specific characteristics of each hand-held unit**);

- establishing a communication link between the mobile gateway and the first and second mobile clients (**Figures 1-4, col.6 line 1-col.8 line 28; proxy server implementing the InterBrowser program achieves the function of the mobile gateway, wherein a communication link is formed with the hand-held mobile units**); and

- sending the first transformed content to the first mobile client and sending the second transformed content to the second mobile client (**col.8 lines 3-59, col.11 lines 22-48, col.15 lines 1-65 and col.25 lines 17-39; content is transmitted to the respective mobile unit based upon the user ID of the device and its pre-stored operating capabilities**).

Yet *Kikinis* fails to explicitly teach: receiving a list from the content server

containing addresses for a plurality of mobile clients, including the first mobile client and the

second mobile client; the content, from the content server, being addressed to the list; identifying

an address for each mobile client contained within the list, including the first mobile client and the second mobile client; and addressing the first transformed content to the first mobile device and addressing the second transformed content to the second mobile device using the plurality of addresses received in the list. However, *Verkler et al* disclose a mobile gateway that maintains a list of address of each client and thus routes messages to clients according to their associated addresses in the list (**col.7 line 50-col.8 line 17, col.9 lines 16-22 and col.10 lines 24-29**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Kikinis* and *Verkler et al* for the purpose of using a list in order to maintain mobile client addresses and information and furthermore to transmit the transformed/tailed content specific to the users based upon their addresses in the list because it would provides maintenance and tracking of the mobile devices communicating in the system.

b.   **Claims 17 and 33** contain limitations substantially equivalent to the limitations of claim 1 and are therefore rejected under the same basis.

c.   **Per claims 10 and 27** (differ by statutory subject matter), *Kikinis* teaches a computerized system that includes a content server, a mobile gateway, and a first mobile client, wherein the mobile gateway receives from the content server, content that is addressed to the first mobile client, a method of customizing the content based on at least one operating characteristic of the first mobile client, wherein the customizing avoids further processing at the content server, the method comprising a mobile gateway performing the acts of:

- assigning a first transform to the first mobile client, the first transform specifically considering one or more operating characteristics of the first mobile client (**col.11 lines 12-48, col.13 lines 35-66 and col.15 lines 1-65; specific translations and**

processes are performed on content prior to transmission to the specific user devices, wherein the transposing of data performed according to pre-stored characteristics of the users' devices);

- receiving content from the content server (**Figures 1-5, col.13 lines 35-66 and col.15 lines 1-65; content is received from content/web/proxy server**);

- altering the content according to the first transform so that the content is compatible with the one or more operating characteristics of the first mobile client, the altered content comprising a first transformed content (**col.11 lines 12-48, col.12 lines 11-27, col.13 lines 35-66, col.15 line 1-col.16 line 48 and col.28 lines 30-63; content is transposed according to the specific characteristics of each hand-held unit**);

- establishing a communication link between the mobile gateway and the first mobile client (**Figures 1-4, col.6 line 1-col.8 line 28; proxy server implementing the InterBrowser program achieves the function of the mobile gateway, wherein a communication link is formed with the hand-held mobile units**); and

- sending the first transformed content to the first mobile client (**col.8 lines 3-59, col.11 lines 22-48, col.15 lines 1-65 and col.25 lines 17-39; content is transmitted to the respective mobile unit based upon the user ID of the device and its pre-stored operating capabilities**).

Yet *Kikinis* fails to explicitly teach: a configuration transform; determining that a change has occurred in at least one service available to the first mobile client; customizing configuration information relative to the change in the at least one service available to the first mobile client based on the first configuration transform to provide first transform configuration information; and sending the transformed configuration to the first mobile client. However, *Verkler et al* disclose a message gateway that provides automatic configuration to clients. The gateway maintains all configuration information and all clients are registered in the gateway. Furthermore information is customized relative to determined communication and service

changes with the mobile client device and then sent to the mobile client device (**col.6 lines 16-43, col.7 line 50-col.8 line 17 and col.9 line 1-col.10 line 29**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Kikinis* and *Verkler et al* for the purpose of using permitting a configuration transform, along with other tailored-transformed data, based on the type of configuration needs of the client device and thus sending the configuration transform to the client device. Furthermore, it would have been obvious to monitor/track service changes with the client device for maintaining an up-to-date registry list of the devices and changes affecting their communication in the system.

d. **Per claim 2**, *Verkler et al* teach the method as recited in claim 1 further comprising the act of at least one of the transforms encrypting the content (**col.7 lines 50-63**).

e. **Claims 12 and 29** are substantially equivalent to claim 2 and are therefore rejected under the same basis.

f. **Per claim 3**, *Verkler et al* teach the method as recited in claim 1 further comprising the act of at least one of the transforms compressing the content (**col.8 lines 17-19**).

g. **Claims 13 and 30** are substantially equivalent to claim 3 and are therefore rejected under the same basis.

h. **Per claim 4**, *Kikinis* teaches the method as recited in claim 1 wherein at least one of the mobile clients is one of a telephone, a pager, a personal digital assistant, or a cascaded mobile gateway (**col.5 lines 36-49 and col.8 lines 47-59**).

i. **Claims 15 and 21** are substantially equivalent to claim 4 and are therefore rejected under the same basis.

j.   **Per claim 5,** *Kikinis* teaches the method as recited in claim 1 wherein the first

transformed content comprises a notification that additional content is available at the content

server, the method further comprising the acts of: receiving a request for the additional content

from the first mobile client (**col.3 line 19-col.4 line 4**); retrieving the additional content from the

content server (**col.3 line 19-col.4 line 15**); altering the additional content according to the first

transform so that the content is compatible with the one or more operating characteristics of the

first mobile client, the act of altering producing a first transformed additional content (**col.2 line**

63-col.3 line 7 and col.4 lines 5-25); and sending the first transformed additional content to the

first mobile client (**Abstract and col.2 line 63-col.4 line 25**).

k.   **Claims 14, 22 and 31** are substantially equivalent to claim 5 and are therefore

rejected under the same basis.

l.   **Per claim 6,** *Kikinis* teaches the method as recited in claim 1 wherein the one or

more operating characteristics considered by the first and second transforms include at least one

of the first and second mobile client's software, processor, memory, display, or communication

link (**col. 2 line 63-col.3 line 7, col.8 lines 15-46, col.15 line 32-col.16 line 48 and col.25 line**

41-col.26 line 18; mobile unit's characteristics are inclusive of CPU type, power, display

size, type and resolution, sound capability, etc—furthermore, the user can modify a

template to add additional characteristics or preferences for tailoring the content).

m.   **Claims 11, 23 and 28** are substantially equivalent to claim 6 and are therefore

rejected under the same basis.

n.   **Per claim 7,** *Kikinis* teaches the method as recited in claim 1 wherein the

computerized system includes a third mobile client, the method further comprising the acts of:

assigning the first transform to the third mobile client, the first transform specifically considering one or more operating characteristics of the third mobile client (**col. 2 line 63-col.3 line 7 and col.25 line 41-col.26 line 50; utilizing templates allows for common mobile devices to receive the same converted data, thus data transposed for a first device may also be sent to another device if it has similar operating characteristics and/or template**); and sending the first transformed content to the third mobile client (**col.25 line 41-col.26 line 50; content is transmitted to the corresponding requesting device after content is transposed according to the template and/or operating characteristics for that particular device**).

o.   **Claims 19, 24 and 35** are substantially equivalent to claim 7 and are therefore rejected under the same basis.

p.   **Per claim 18,** *Verkler et al* teach the method as recited in claim 17 wherein the content received from the content server is addressed to a list containing the first and second mobile clients, the method further comprising the act of addressing the content specifically to the first mobile client and to the second mobile client as defined in the list (**col.7 line 50-col.8 line 17, col.9 lines 16-22 and col.10 lines 24-29**).

q.   **Claim 34** is substantially equivalent to claim 18 and is therefore rejected under the same basis.

r.   **Per claim 9,** *Kikinis* teaches the method as recited in claim 1 wherein the content comprises one of email, calendar, contact, task, Web, notification, financial, configuration, and sports content (**col.8 line 47-col.9 line 65 and col.10 lines 21-col.11 line 48**).

s.   **Claims 16 and 27** are substantially equivalent to claim 9 and are therefore rejected under the same basis.

    t.   **Claim 32** is substantially equivalent to claims 4 and 9 and is therefore rejected under the same basis.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Cragun* (USPN 6,785,680), *Reisman* (USPN 6,125,388), *Himmel* (USPN 6,167,441), *Payne et al* (USPN 6,021,433), *Mousseau et al* (USPN 6,779,019), *Kloba et al* (USPN 6,421,717), *Rouse et al* (US 20020103908) and *Hwang et al* (US 20020107985).

5.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER